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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/527,453

03/17/2000

MASAAKI HORI

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09/10/2004

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EXAMINER

BURLESON, MICHAEL L

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/527,453

Applicant(s)

HORI, MASA AKI

Examiner

Michael Burleson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>9</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3,7</u> . | 6) <input type="checkbox"/> Other: ____. |

Response to Amendment

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Information Disclosure Statement

2. The information disclosure statement (IDS) was submitted on March 17, 2000. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

3. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kato US 2002/0048040 in view of Sidhu et al. US 5734901.
4. Regarding claim 1, Kato teaches of a communication apparatus (page 1, paragraph 0025, lines 1-2), that attaches scanned data from a facsimile apparatus to an e-mail (page3, paragraph 0038, lines 3-5), for use with a telephone exchange that is

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connected to the internet (page 2, paragraph 0026, lines 8-10), which reads on an information network. The communication apparatus includes a personal computer, which includes a keyboard (page 2, paragraph 0026, lines 4-5; figure 1 and paragraph 0028, lines 1-2), which reads on a recipient inputting device.

Kato fails to teach of a notation inputting device that inputs notation that informs whether the e-mail is addressed to the recipient or the e-mail is transmitted as a courtesy copy, and that correlates the notation to the recipient's information and a transmission device that transmits facsimile data by attaching the facsimile data to the e-mail, based on recipient's information input by the recipient's information inputting device and the notation input by the notation inputting device.

Sidhu et al. teaches of an addressing panel (800) that has a Cc: icon (621) which can be selected by the user (column 10, lines 60-67, column 12, lines 11-21 and figure 8), which reads on a notation inputting device that inputs notation that informs whether the e-mail is addressed to the recipient or the e-mail is transmitted as a courtesy copy, and that correlates the notation to the recipient's information. He also teaches that facsimile addresses can be used to transmit data via e-mail (column 12, lines 17-20). The computer system (100) transmits electronic messages between systems (column 5, lines 36-38), which reads on a transmission device that transmits facsimile data by attaching the facsimile data to the e-mail, based on recipient's information input by the recipient's information inputting device and the notation input by the notation inputting device.

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Kato could have easily been modified with the addressing panel and computer system of Sidhu et al. This modification would have been obvious to one skilled in the art at the time of the invention to transmit facsimiles via e-mail as a courtesy copy.

5. Regarding claims 2, Sidhu et al. teaches of a keyboard (122) that the operator can use to input a receiver's name, which reads on a piece of a recipient's information for one piece of the e-mail (column 10, lines 60-67 and column 12, lines 11-15)).

6. Regarding claim 3, Sidhu et al. teaches addressing panel (800) that has a BCC, CC icon (621) and To icon (622), which can be selected by the user (column 10, lines 60-67, column 12, lines 11-21 and figure 8), which reads on a plurality of notations and correlates each of the plurality of notations to each of the pieces of the recipients information input by the recipient's information inputting device.

7. Regarding claim 4, Sidhu et al. teaches of a keyboard (122) (figure 1), which reads on a writing device that writes information into a body of the e-mail before transmitting the e-mail by the transmission device.

8. Regarding claim 5, Kato teaches the facsimile apparatus of the communication apparatus that scans a document and attaches the scanned data to an e-mail (page 3, column 0038, lines 3-6), which reads on a reading device that reads from an original document, the facsimile data to be attached to e-mail and then transmitted.

9. Regarding claim 6, Kato teaches the facsimile apparatus also transmits and receives facsimile data by a public line (page 2, paragraph 0026, lines 14-16), which reads on a facsimile data transmission/reception device that only transmits/receives the facsimile data by a public line.

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10. Regarding claim 7, Kato teaches all of the limitations of claim 7, but fails to teach of a disclosure information inputting device that inputs disclosure information as to whether or not disclosure of other broadcast recipients is required, according to the pieces of the recipient's information input by the recipient's information inputting device, and that correlates the disclosure information to the recipient's information.

Sidhu et al. teaches of an addressing panel (800) (column 12, lines 11-15 and figure 8), which reads on a disclosure information inputting device that inputs disclosure information as to whether or not disclosure of other broadcast recipients is required, according to the pieces of the recipient's information input by the recipient's information inputting device, and that correlates the disclosure information to the recipient's information.

Kato could have easily been modified with the addressing panel of Sidhu et al. This modification would have been obvious to one skilled in the art at the time of the invention to transmit facsimiles via e-mail to other recipients.

11. Regarding claim 8, claim 8 is rejected for the same reasons as claim 4.

12. Regarding claim 9, claim 9 is rejected for the same reasons as claim 5.

13. Regarding claim 10, claim 10 is rejected for the same reasons as claim 6.

14. Regarding claim 11, Kato teaches all of the limitations of claim 11, but fails to teach of a notation inputting device, a disclosure information inputting device and a transmission device.

Sidhu et al. teaches of an addressing panel (800) that has a Cc: icon (621) which can be selected by the user (column 10, lines 60-67, column 12, lines 11-21 and figure

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8), which reads on a notation inputting device that inputs notation that informs whether the e-mail is addressed to the recipient or the e-mail is transmitted as a courtesy copy, and that correlates the notation to the recipient's information. He teaches of an addressing panel (800) (column 12, lines 11-15 and figure 8), which reads on a disclosure information inputting device that inputs disclosure information as to whether or not disclosure of other broadcast recipients is required, according to the pieces of the recipient's information input by the recipient's information inputting device, and that correlates the disclosure information to the recipient's information. He also teaches that facsimile addresses can be used to transmit data via e-mail (column 12, lines 17-20). The computer system (100) transmits electronic messages between systems (column 5, lines 36-38), which reads on a transmission device that transmits facsimile data by attaching the facsimile data to the e-mail, based on recipient's information input by the recipient's information inputting device and the notation input by the notation inputting device.

Kato could have easily been modified with the addressing panel and computer system of Sidhu et al. This modification would have been obvious to one skilled in the art at the time of the invention to transmit facsimiles via e-mail to other recipients.

15. Regarding claim 12, claim 12 is rejected for the same reasons as claims 4 and 8.
16. Regarding claim 13, claim 13 is rejected for the same reasons as claims 6 and 10.
17. Regarding claim 14, Sidhu et al. teaches of an addressing panel (800) (column 10, lines 60-67, column 12, lines 12-15 and figure 8), which reads on notation inputting

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device and the disclosure information inputting device are a common device and the notation and the disclosure information are common information.

18. Regarding claim 15, Kato also teaches of a storage medium for storing computer programs (page 2, paragraph 0031, lines 3-6 and page 4, paragraph 0055, lines 6-21), which reads on a storage medium for storing a program for controlling a facsimile apparatus that transmits facsimile data by attaching the facsimile data to electronic mail for use in an information network and a recipient's information inputting program for inputting information of a recipient to whom the e-mail is transmitted.

Kato fails to teach of a storage medium that stores notation inputting program, a disclosure information inputting program and a transmission program.

Sidhu et al. teaches of a static memory (106) (figure 1), which reads on a storage medium for storing notation inputting program for inputting notation that informs whether the e-mail is addressed to the recipient or the e-mail is transmitted as a courtesy copy and for correlating the notation to the recipient's information, a disclosure information inputting program for inputting disclosure information as to whether or not disclosure of other recipients is required, according to the recipient's information input by the recipient's information inputting program and for correlating the disclosure information to the recipient's information an a transmission program for transmitting the facsimile data by attaching the facsimile data to the e-mail, based on the recipient's information input by the recipient's information inputting program, the notation input by notation inputting program and the disclosure information input by the disclosure information input program.

Kato could have easily been modified the static memory of Sidhu et al. This modification would have been obvious to one skilled in the art at the time of the invention in order to store the notation, disclosure and transmission programs.

19. Regarding claim 16, Kato also teaches of a storage medium for storing computer programs (page 2, paragraph 0031, lines 3-6 and page 4, paragraph 0055, lines 6-21), which reads on a storage medium for storing a program for controlling a facsimile apparatus that transmits facsimile data by attaching the facsimile data to electronic mail for use in an information network and a recipient's information inputting program for inputting information of a recipient to whom the e-mail is transmitted.

Kato fails to teach of a storage medium that stores a disclosure information inputting program and a transmission program.

Sidhu et al. teaches of a static memory (106) (figure 1), which reads on a storage medium for storing a disclosure information inputting program for inputting disclosure information as to whether or not disclosure of other broadcast recipients is required, according to the pieces of the recipient's information input by the recipient's information inputting program and for correlating the disclosure information to the recipient's information and a transmission program for transmitting the facsimile data by attaching the facsimile data to the e-mail, based on the recipient's information input by the recipient's information inputting program and the disclosure information input by the disclosure information inputting program.

Kato could have easily been modified the static memory of Sidhu et al. This modification would have been obvious to one skilled in the art at the time of the invention in order to store the disclosure and transmission programs.

20. Regarding claim 17, Kato also teaches of a storage medium for storing computer programs (page 2, paragraph 0031, lines 3-6 and page 4, paragraph 0055, lines 6-21), which reads on a storage medium for storing a program for controlling a facsimile apparatus that transmits facsimile data by attaching the facsimile data to electronic mail for use in an information network and a recipient's information inputting program for inputting information of a recipient to whom the e-mail is transmitted.

Kato fails to teach of a storage medium that stores notation inputting program, a disclosure information inputting program and a transmission program.

Sidhu et al. teaches of a static memory (106) (figure 1), which reads on a storage medium for storing notation inputting program for inputting notation that informs whether the e-mail is addressed to the recipient or the e-mail is transmitted as a courtesy copy and for correlating the notation to the recipient's information and a transmission program for transmitting the facsimile data by attaching the facsimile data to the e-mail, based on the recipient's information input by the recipient's information inputting program and the notation input by notation inputting program.

Kato could have easily been modified the static memory of Sidhu et al. This modification would have been obvious to one skilled in the art at the time of the invention in order to store the notation and transmission programs.

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21. Regarding claim 18, Sidhu teaches that addressing panel (800) BCC is available at the position of CC icon (621) (column 10, lines 63-67), which reads on the disclosure information is a notation of a blind courtesy copy.
22. Regarding claim 19, claim 19 is rejected for the same reasons as claim 18.
23. Regarding claim 20, claim 20 is rejected for the same reason as claim 18.
24. Regarding claim 21, claim 21 is rejected for the same reason as claim 18.

Conclusion

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

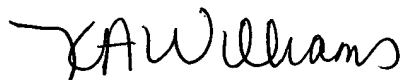
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bloomfield US 6,025,931 and Witek US 5,461,488.

27. Any inquiry concerning this communication should be directed to Michael Burleson whose telephone number is (703) 305-8683 and fax number is (703) 746-3006. The examiner can normally be reached Monday thru Friday from 8:00 a.m. – 4:30p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached at (703) 305-4863


KIMBERLY WILLIAMS
SUPERVISORY PATENT EXAMINER

Michael Burleson
Patent Examiner
Art Unit 2626

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MIb
September 3, 2004